

REMARKS

Claims 1-5, 8-26 and 28-31 are pending in the present application. By this reply, claims 7, 14 and 27 have been canceled, and claims 1, 9 and 15 have been amended. Claims 1, 9 and 15 are independent.

Claims 1, 9 and 15 have been amended to include, respectively, the subject matter of claims 7, 14 and 27. These modifications do not add new matter.

Personal Interview

Applicant acknowledges with appreciation the courtesies extended by Examiner Madamba to their below-named representative, Mr. Robert J. Webster, during a personal interview conducted on August 27, 2007. During that interview, Mr. Webster presented arguments to the effect that claims 7, 14 and 27 patentably define over the applied art, and that Applicant proposes to amend independent claims 1, 9 and 15 to, respectively, include the features of claims 7, 14 and 27, and showed a copy of the proposed claim amendments to Examiner Madamba. Examiner Madamba indicated that such an amendment should be entered and considered on its merits, and that further consideration of such claims would require an update search.

35 U.S.C. § 102 and 103 Rejections

Claims 1, 3-5, 9, 12, 15, 18-23, 25-26, 28-29 and 31 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Smyers (U.S. Patent 6,430,629) in view of Sitnik (U.S. Patent 6,988,276).

This rejection is respectfully traversed.

Because the rejection is based on 35 U.S.C. § 103, what is in issue in such a rejection is "the invention as a whole, "not just a few features of the claimed invention. Under 35 U.S.C. § 103, " [a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under §103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. See In re O'Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. See Medtronic, Inc. v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v Delta Resins & Refactories, Inc., 776 F.2d 281, 293, 227 USPQ 657,

664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, it is well settled that the Office must provide objective evidence of the basis used in a prior art rejection. A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Furthermore, during patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re, Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the Applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the applicant to come forward to rebut such a case.

Smyers discloses a home network controlling a variety of devices including a set top box, a video cassette recorder, a digital camera and a thermometer, with a user interface 160 that can be built directly into the monitor (col. 2, lines 23-33). Smyers has no disclosure of a TV set being used as a master controller.

Sitnik teaches away from using a TV set as a master in a master/slave arrangement. Instead, Sitnik teaches peer-to-peer network, which is definitely not a master/slave relationship.

Thus, Sitnik teaches away from using a TV as a master in a master/slave relationship/

Moreover, independent claims 1, 9 and 15 have been amended to incorporate the subject matter of claims 7, 14 and 27, respectively, thus reciting a combination of features that is neither disclosed nor suggested by either Smyers or Sitnik. In this regard, Applicant respectfully notes that neither Smyers nor Sitnik disclose or suggest wherein (1) the operation status data includes data related to specific functions performed by the plurality of slave devices, (2) the television (TV) receiver includes a capability to activate a message BLOCK function which prevents messages sent from the at least one slave device from being displayed, and (3) the memory cumulatively stores the operation status data included in each response signal even when the message BLOCK function of the television (TV) receiver is currently activated, as recited in claims 1 or 9, or extracting data from the operation history database when a history inquiry

request is received from a user, wherein the extracted operation history data is displayed on a display unit; activating a message BLOCK function which prevents messages sent from the plurality of slave devices from being displayed; and continuing to cumulatively store the operation status data in each response signal even when the message BLOCK function is activated, as recited in claim 15.

Furthermore, because the subject matter of claims 7, 14 and 27 has been added, respectively, to claims 1, 9 and 15, and claims 7, 14 and 27 stand rejected under 35 USC §103(a) over Smyers in view of Klosterman (U.S. Patent Application Publication 2002.0092017), this rejection will be traversed, as follows.

Initially, Applicant notes that Smyers admittedly does not disclose the claimed television master control device, and no secondary reference is applied to render providing such a device obvious. Moreover, Klosterman is not applied to provide this admittedly missing feature of the claimed invention. For at least this reason, the Office Action fails to make out a *prima facie* case of obviousness of the claimed invention.

Klosterman has nothing to do with home networks, in general, or to home networks using master/slave devices, but is directed to substituting alternative video and/or audio signals and/or graphics and/or text that what is normally broadcast to, and displayed by, a TV set. For example, Klosterman replaces and/or modifies advertisements that are displayed on a TV set. Klosterman optionally provides an electronic programming guide (EPG) generating system that is optionally programmable to block the audio and video of a TV program when the EPG is activated.

This has nothing to do with the claimed invention, which positively recites a capability to activate a message block function, which prevents messages sent from at least one slave device from being displayed.

Klosterman differs significantly from both the claimed invention and from Smyers. Klosterman intercepts TV program commercial signals broadcast from a TV station to a TV set, blocks those intercepted signals from being displayed on that TV set, and replaces those broadcast signals with other audio and/or video signals that are contained in various databases. Klosterman contains no disclosure of receiving messages from a slave and, because of this, Klosterman does not disclose blocking such non-existent and, thus, non-received, messages on a TV set. Smyers also does not disclose activating a function blocking messages from a slave device. Because neither applied reference discloses such a feature, there is no basis in the rejection for providing the capability of activating a message block function which prevents messages sent from at least one slave device from being displayed, or the claimed combination of features recited in claims 1, 9 and 15.

Additionally, whereas the claimed invention uses its message blocking feature to continually broadcast a regular TV program without interruption, Klosterman interrupts its broadcast TV program to substitutes its own audio and video for the interrupted broadcast.

Applicant respectfully submits that the only basis for arriving at the claimed invention is Applicant's own disclosure, which cannot properly be used against Applicant.

Accordingly, reconsideration and withdrawal of this rejection of claims 1, 3-5, 9, 12, 15, 18-23, 25-26, 28-29 and 31 are respectfully requested.

Claims 2, 11, 13, 16 and 17 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Smyers in view of Dara-Abrams et al. This rejection is respectfully traversed.

Initially, Applicant notes that Smyers admittedly does not disclose the claimed television master control device, and no secondary reference is applied to render providing such a device obvious. Moreover, Dara-Abrams is not applied to provide this admittedly missing feature of the claimed invention. For at least this reason, the Office Action fails to make out a *prima facie* case of obviousness of the claimed invention.

Additionally, neither applied reference discloses or suggests the features added to claims 1, 9 and 15, from which the claims under rejection depend. For this additional reason, claims 2, 11, 13, 16 and 17 patentably define over the applied art.

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Claims 7, 14 and 27 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Smyers in view of Klosterman et al (U.S. Patent Application Publication 2002/0092017). This rejection is respectfully traversed.

This rejection is moot because that claims 7, 14 and 27 have been canceled. However, because the subject matter of claims 7, 14 and 237 has been added, respectfully, to claims 1, 9 and 15, this ground of rejection is discussed above regarding the traversal of the rejection of claims 1, 9 and 15.

Claims 8, 10, 24 and 30 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Smyers in view of Aizu et al. (“Aizu”). These rejections, insofar as they pertain to the presently pending claims, are respectfully traversed.

Initially, Applicant notes that Smyers admittedly does not disclose the claimed television master control device, and no secondary reference is applied to render providing such a device obvious. Moreover, Aizu is not applied to provide this admittedly missing feature of the claimed invention. For at least this reason, the Office Action fails to make out a *prima facie* case of obviousness of the claimed invention.

Additionally, neither applied reference discloses or suggests the features added to claims 1, 9 and 15, from which the claims under rejection depend. For this additional reason, claims 8, 10, 24 and 30 patentably define over the applied art.

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Claim 24 stands rejected under 35 USC §103(a) as being unpatentable over Smyers in view of Aizu and further in view of Sitnik. This rejection is respectfully traversed.

Claim 24 depends from claim 15 and claim 15 is not rendered obvious by the Smyers-Aizu reference combination for reasons discussed above. Moreover, Sitnik is not applied in this rejection to remedy the aforenoted deficiencies of the Smyers-Aizu reference combination with respect to claim 15, from which claim 24 depends.

Accordingly, regardless of whether one of ordinary skill in the art were properly motivated to modify the Smyers-Aizu reference combination in view of Sitnik, the so modified version of Smyers-Aizu would not render the claimed invention obvious.

Moreover, Sitnik teaches away from using a TV set as a master in a master/slave arrangement. Instead, Sitnik teaches peer-to-peer network, which is definitely not a master/slave relationship. Because of this, Applicant respectfully submits that one of ordinary skill in the art would not be properly motivated to modify the Smyers-Aizu reference combination in view of Sitnik.

Accordingly, the Office Action does not make out a *prima facie* case of obviousness of the invention recited in claim 24.

Reconsideration and withdrawal of this rejection of claim 24 are respectfully requested.

CONCLUSION

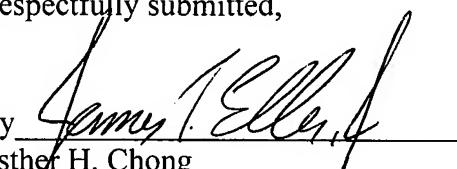
In view of the above amendment, Applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Esther H. Chong Reg. No. 40,953 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By 
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